

## **REMARKS**

### **I. Introduction**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

### **II. Summary of the Claims and Amendments Thereto**

Claims 5-31, 33-35, and 40-43 were cancelled previously. Claims 1-4, 32, 36-39, and 44-54 are therefore pending.

Claims 1 and 51 are amended to clarify that a pharmaceutical composition is being claimed and administered, respectively. Claims 4, 46, 49, and 52 are amended to show the structures of compounds. Claim 2 is amended to correct a minor grammatical error, while claims 36 and 37 are amended to correct their dependencies in light of their parent claims being cancelled.

### **III. The Office Action**

#### **A. Claim Objection**

The PTO stated that it would object to claim 4 as being a substantial duplicate of claim 2 should the latter be found allowable. Office Action at page 3. Applicants disagree with the PTO's proposed course of action. Claim 2 delineates a genus of compounds, one of which can be the compound claimed in claim 4. A genus is not a "substantial duplicate" of a species, and therefore claim 4 does not claim the same scope of subject matter as is claimed in claim 2.

#### **B. Rejection of Claims Under 35 U.S.C. § 112, First Paragraph**

The PTO rejected claims 32 and 37 under U.S.C. § 112, first paragraph as allegedly lacking enablement. Office Action at pages 3-7. The PTO stated that the claims are unduly broad with respect to medical indications in view of Applicants' explicit teachings, and the state of and predictability of the art, such that undue experimentation would be incumbent

upon a skilled person seeking to practice the invention. Applicants respectfully traverse the rejection.

The claims are enabled because Applicants have provided sufficient guidance as to the treatment of cell proliferative disorders with the recited compounds. The specification discusses at length the mechanisms underlying cell proliferative disorders. First, such disorders are linked to defects in signaling pathways that are mediated by receptor tyrosine kinases. *See* specification at page 3, lines 19-25. Second, Applicants identified examples of receptors that regulate or are otherwise associated with a number of cell proliferative disorders. *Id.* at pages 3, line 26 to page 5, lines 16. Finally, Applicants demonstrated that the compounds of the invention can inhibit those kinase activities underlying cell proliferative disorders. *Id.* at page 89 (Table V).

Taken together, Applicants' teaching and experimental data provide a wealth of guidance that enables the claimed treatment of cell proliferative disorders by the administration of the recited compounds. Consequently, Applicants respectfully request the PTO to reconsider and withdraw this rejection.

### **C. Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph**

The PTO rejected claims 4, 46, 49, and 52 under 35 U.S.C. § 112, second paragraph as being allegedly indefinite for reciting only compound numbers. The amendments to the claims moot this rejection because compound structures are now explicitly recited.

The PTO also rejected claim 32 because a chemical structure inadvertently obscured a portion of the claim text. Applicants amended the claim to remove the structure.

Finally, the PTO rejected claims 36 and 37 for depending upon cancelled claims 30 and 31. Claims 36 and 37 are amended to correct their dependencies, and this ground for rejection therefore is moot.

**D. Rejection of Claims Under 35 U.S.C. § 102**

The PTO rejected claims 1-4 under 35 U.S.C. § 102(b) as being allegedly anticipated by WO 95/24190 to Chen *et al.* (“Chen”) and Ohmichi *et el.* (“Ohmichi”). Office Action at page 8. The PTO relied upon the cited references for their separate disclosures of the same compound designated “M13” and “1007”, respectively. Applicants respectfully traverse the rejection.

Chen is not prior art for at least the reason that the present application and Chen share the same priority date, and in fact they claim the benefit of priority of the same application (U.S. Patent Application No. 08/207,933, filed on March 7, 1994). Consequently, Chen cannot anticipate the claims, and it therefore fails to support this ground for rejection.

Ohmichi is not prior art under section 102(b) because, according to the American Chemical Society journal archives, it was published on May 4, 1993 (*see Exhibit A*). The publication date is less than one year before the earliest effective filing date of the present application (March 7, 1993). *See* 35 U.S.C. § 102(b).

In any event, while Ohmichi may disclose a compound satisfying the structural requirements recited in claim 1, it does not teach or suggest a pharmaceutical composition as claimed in claim 1. Specifically, Ohmichi does not teach or suggest a pharmaceutical composition comprising the compound and a physiological acceptable carrier. Because Ohmichi fails to disclose at least these elements of the claimed invention, Ohmichi does not anticipate the claims. Accordingly, Applicants respectfully request the PTO to reconsider and withdraw this rejection.

**E. Rejection of Claims Under 35 U.S.C. § 103**

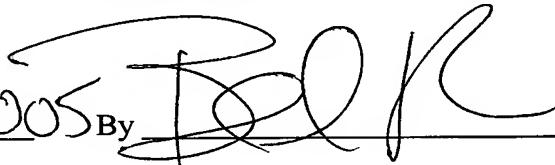
The PTO rejected claims 1-4, 32, 36-39, and 44-54 under 35 U.S.C. § 103 as being allegedly unpatentable over Chen. Office Action at pages 10-11. The PTO stated that the claimed compounds and uses are related by “generic description” to those disclosed in Chen. Applicants respectfully traverse this rejection because Chen is not available as prior art for the

reasons discussed immediately above. Accordingly, Applicants respectfully urge the PTO to withdraw this rejection.

#### IV. Conclusion

Having addressed each issue, Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. Applicants invite Examiner Sackey to contact the undersigned by telephone if he feels that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 16 September 2005 By 

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.